UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,830	07/14/2003	Scott Mutchler	ATT030061/21523-67759	5928

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AT & T Legal Department - MMM
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EXAMINER
MANSFIELD, THOMAS L

ART UNIT	PAPER NUMBER
3624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2009*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-7,11,15,18,19,22,23,29,32 and 33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-7, 11, 15, 18, 19, 22, 23, 29, 32, and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendments

1.   This Continued Examination Office Action is in reply to the Request for Continued Examination filed on 29 April 2009.

2.   Claims 1, 3, 5, 11, 15, 18, 19, 22, 29, 32, and 33 have been amended.

3.   Claims 2, 8-10, 12-14, 16, 17, 20-21, 24-28, 30, 31, and 34-36 have been cancelled.

4.   Claims 1, 3-7, 11, 15, 18, 19, 22, 23, 29, 32, and 33 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

5.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.   Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 April 2009 has been entered.

Response to Arguments

6.   Applicant's arguments filed 29 April 2009 have been fully considered but they are moot based on a new grounds of rejection.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.   Claims 1, 3-7, 11, 15, 18, and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See In Re Bilski*, 88 U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should <u>positively recite</u> the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter. Dependent Claims 3-7, 11, 15, 18, and 19 are rejected for the same reasons and rationale as independent Claim 1 above.

9.   Claims 32 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is not

supported by either a specific and substantial asserted utility or a well established utility.

Claim 32 recites a system for defining and evaluating a set of business rules. Although Claim 32

recites a system, there is no structure to support the results of the creating, specifying, defining,

linking, generating, updating and adding. Claim 33 depends from Claim 32 and has the same

deficiencies and missing elements and is rejected for the same rationale.

10.   Claims 22, 23, and 29 are rejected under 35 U.S.C. 101 because the claimed invention is not

supported by either a specific and substantial asserted utility or a well established utility.

Claim 22 recites functional descriptive material (i.e. modules) that do not impart functionality

when employed as a computer component because the functional descriptive material is not

tangibly embodied on a computer-readable medium that causes one or more processors to

impart functionality. (See MPEP 2106.01(I)). Claims 23 and 29 depend from Claim 22 and have

the same deficiencies and missing elements and are rejected for the same rationale.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12.   Claims 1, 3-7, 11, 15, 18, 19, 22, 23, 29, 32, and 33 are rejected under 35 U.S.C. 102(e) as being

anticipated by Agostini et al. (Agostini) (US 2003/0084428 A1).

As per claims 1, 5-7, 22, and 32, Agostini teaches *a method/computer-readable*

medium/system of defining and evaluating a set of business rules during runtime of a software

application program in a computer system, the method/computer-readable medium/system

comprising:

during runtime of the software application program, creating a rule category for the set of

business rules (each executable rule file is individually created) (see at least paragraph 7);

(a) specifying a current rule of the set of business rules (rule selection repository) (see at

least paragraphs 7-8);

(b) defining a state object for the current rule (identifiers, group **388**)*, wherein the state*

object comprises user data relevant to the current rule (see at least paragraphs 37-40);

*(c) defining **at least one** condition for the current rule* (market condition of the customer

order), *wherein the **at lease one** condition comprises a decision based on data made available to*

the software application (conforms to business logic rules), *and the **at least one** condition is a*

pattern condition, a structured query language (SQL) condition, or a script condition (suitable

mark-up language, XML) (see at least paragraphs 49-54);

*(d) defining **at least one** action for the current rule, wherein the **at least one** action is*

*based on the **at least one** condition* (perform an analysis of the status indicators **361**) (see at

least paragraphs 49-54);

*(e) linking the **at least one** conduction with the **at least one** action to define a business*

rule from the current rule (dynamic rule selector **349**) (see at least paragraphs 63-65);

(f) a database for storing/generating/saving a data file the current rule in the rule category

for the set of rules (rule engine **340**, rule generator **310**, rule selection repository **330**, data

repository **350**) (see at least paragraphs 39-41);

(g) repeating operations (a)-(f) until each business rule in the set of business rules has been defined; rules engine module/retrieving a business rule; evaluating the business rule based on the **at least one** *defined condition for the business rule, the* **at least one** *defined action for the business rule, and the user data in the state object defined for the business rule, including examining the user data in the state object based on* **at least one** *of the pattern condition, the SQL condition, and the script condition; and updating or adding new user data to the state object based on the evaluation of the business rule using* **at least one** *of the pattern action, the SQL action, and the script action* (see at least paragraphs 41-54).

As per claims 3 and 23 Agostini teaches *the user data comprises fields stored in a database* (see at least paragraph 45).

As per claim 4, Agostini teaches *the* **at least one** *user action updates the fields in the database during runtime of the software application* (see at least paragraph 45-47).

As per claims 11 and 29, Agostini teaches *the pattern action uses dynamic binding or reflection to update or add new user data to the state object* (dynamic rule selector **349**) (see at least paragraph 72)).

As per claims 15 and 33, Agostini teaches *determining a success of the business rule based on the evaluation* (conform, nonconforming) (see at least paragraphs 52-54).

As per claims 18 and 19 Agostini teaches *the business rule is retrieved from a database/file* (see at least paragraph 51).

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Haley et al. (U.S. Pub. No. 2002/0196295) discloses a system and user interface supporting use of customizable expressions by applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Examiner, Art Unit 3624

15 July 2009
Thomas Mansfield

/Scott L Jarrett/
Primary Examiner, Art Unit 3624